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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/789,268 | 02/26/2004 | Bradley R. Stager | P 0555.14107 | 9398 |
| 74310 7590 09/23/2008 Portland Intellectual Property, LLC 900 SW Fifth Avenue, Suite 1820 Portland, OR 97204 | | | | |
| EXAMINER | | | | |
| MILLER, BENA B | | | | |
| ART UNIT | | PAPER NUMBER | | |
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| 09/23/2008 | | PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/789,268

Applicant(s)

STAGER, BRADLEY R.

Examiner

Bena Miller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,7,9-11 and 17-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5,7,9,17,19-21 and 27-29 is/are rejected.
- 7) ☒ Claim(s) 3,4,10,11,18 and 22-26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 08/07/08.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

The remarks in the RCE filed 07/11/08 are duly noted.

Information Disclosure Statement

The information disclosure statement filed 08/07/08 was not considered by the examiner because the US patent document submitted in the IDS is already of record.

Applicants' attention is directed to the Notice of Reference Cited, Form PTO-892, mailed 11/02/07.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3-5, 7, 9-11, 17, 22-27 and 29 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 7-10 of U.S. Patent No. 6,757,052 in view of Bielagus et al (US Patent 5,937,923).

The claims of the instant application recite most of the elements of the patented claims except for a wearshoe. Bielagus teaches a rotary cutter blade clamp having a wearshoe for mounting a knife (114. It would have been obvious to one of ordinary skill in the art to incorporate a wearshoe as suggested by Bielagus in U.S. Patent No. 6,757,052 for the reasons set forth above.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 5, 19, 27 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Bachmann (US Patent 4,347,882).

The device Bachmann teaches the elements of the claimed invention including:

a dual cutting edge knife having spaced-apart first and second sides defining a thickness of the knife (38);

a base (32);

a wearshoe (22);

an upper clamping member (24), said wearshoe for mounting to side of said base and said upper clamping member for mounting to one the other side of said base such that a first portion of said upper clamping member, corresponding to said first side of the knife, extends cantilevered (col. 4, par. 1) over a corresponding second portion of said wearshoe, corresponding to said second side of the knife, so as to define a gap between said portions that is greater than said thickness, for receiving the knife in a first configuration of the apparatus in which the knife is not clamped between said a gap reducing mechanism for elastically deflecting said first portion in the direction of said second portion so as to define a second configuration of the apparatus for clamping the knife in which said gap is reduced sufficiently to conform to said thickness, cooperatively ramping portions (see marked copy figure 4 of Bachmann below; Note, the examiner takes the position that the ramping portions define an angle of 5°) and at least one bolt (30).

Claim 9 is rejected under 35 U.S.C. 102(e) as being anticipated by Loth (US Patent 6,561,885)

The applied reference has a common invention with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Loth teaches the elements of the claimed invention including a knife (fig. 2) having spaced-apart first and second sides defining a thickness of the knife; a base (1.2); a wear shoe (1.6); and an upper clamping member (1.3), for mounting to one side of said base and said wear shoe for mounting to an opposite side of said base, said upper clamping member and said wear shoe having corresponding portions for receiving said first and second sides of said knife, respectively, said portions spaced apart by a gap that is greater than said thickness so that said knife is not clamped between said portions, the apparatus adapted for elastically deflecting said upper clamping member to bring said portions closer together and narrow said gap until sufficient deflection is produced to entirely close said gap whereupon said portions clamp the knife (fig. 2) as recited in claim 1;

at least one bolt (fig.2) mount the wear shoe and base together and includes cooperatively interlocking portions (see marked copy fig. 2 of Loth in previous Office Action) to prevent movement of the base relative to the wear shoe, in a first direction toward the knife and perpendicular to the axis of the bolt, the interlocking portions meeting so as to define an angle with respect to the first direction that is in a range 45-60 degrees as recited in claim 3 (Note the Examiner takes the position that interlocking portions defines an angle between the claimed range, specifically 45 degrees);

a ring assembly comprising two end plates for rotation about an axis of rotation (fig.1); at least two shoulder bolts (fig.3); and a plurality of knife assemblies (fig. 2), each assembly comprising an elongate knife having a cutting edge extending along an elongate axis (fig.2), a clamp for clamping the knife (1.1), and a base (1.2) for

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supporting at least a portion of said clamp, said assemblies for installation between said end plates such that the shoulder portions of said at least two shoulder bolts extend through one of said end plates into said base (fig.3) as recited in claim 9.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bielagus et al.

In the event Applicant disagrees with the above rejection, it would have been obvious to one having ordinary skill in the art, at the time the invention was made, to have the interlocking portions of the wear shoe and base of Bielagus et al to define an angle with respect to the first direction in the range 45-60 degrees and cooperatively ramping portions define an angle about 5 degrees for the purpose of firmly holding the knife in place with a minimum amount of applied force.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Loth in view of Swartwood et al (US Patent 5,979,522).

Loth teaches most of the elements of the claimed invention, except for a dual cutting edge knife. Swartwood teaches that it is well known to use a dual cutting edge

knife with a cutting apparatus, such as a chipper disc (fig.2). It would have been obvious to one of ordinary skill in the art to use a dual cutting knife as suggested by Swartwood with the apparatus of Loth for the purpose of cutting wood chips or flakes form pieces of wood.

Claim 28 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Bielagus et al in view of Swartwood et al (US Patent 5,979,522).

Bielagus et al teaches most of the elements of the claimed invention, except for a dual cutting edge knife. Swartwood teaches that it is well known to use a dual cutting edge knife with a cutting apparatus, such as a chipper disc (fig.2). It would have been obvious to one of ordinary skill in the art to use a dual cutting knife as suggested by Swartwood with the apparatus of Bielagus for the purpose of cutting wood chips or flakes form pieces of wood.

Response to Arguments

Applicant's arguments filed 07/11/011 have been fully considered but they are not persuasive. In response to applicants' arguments, the applicant's attention is directed to the above rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bena Miller whose telephone number is 571.272.4427. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 571-272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Bena Miller/
Primary Examiner, Art Unit 3725
September 21, 2008

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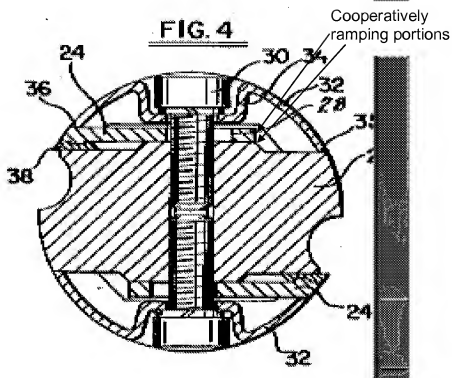


Figure 4 of Bachmann

Allowable Subject Matter

Claims 3, 4, 18, 10, 11 and 22-26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.